

MS APPEAL BRIEF - PATENTS
1517-1032

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Robert C. HOCHTRITT et al. Conf. 7581

Application No. 10/660,659 Group 3651

Filed September 12, 2003 Examiner Timothy R.
Waggoner

DISPENSER FOR FOLDED ABSORBENT
SHEET PRODUCTS

APPEAL BRIEF

MAY IT PLEASE YOUR HONORS

(i) **Real Party in Interest**

The real party in interest in this appeal is the assignee, SCA Tissue North America LLC, of Neenah, Wisconsin.

(ii) **Related Appeals and Interferences**

This is the second trip to the Board for this case. In Appeal No. 2007-3501, the Board issued a decision on June 25, 2008 reversing the final rejections of the same claims that remain pending and are the subject of the present appeal. A newly-assigned Examiner then reopened prosecution and on September 30, 2008 issued a new non-final rejection, newly rejecting those same claims for obviousness based on prior art that was of record at the

time of the first appeal. That September 30, 2008 Official Action fails to establish a *prima facie* case of obviousness, fails to comply with 37 CFR §1.198, disregards the instructions set forth in MPEP §1214.04, and, indeed, does not even mention the Board's June 25, 2008 decision.

(iii) Status of Claims

Claims 1-16 are pending and this appeal is taken from the second rejection of all of the pending claims.

(iv) Status of Amendments

No amendment was filed subsequent to the rejection on appeal.

(v) Summary of the Claimed Subject Matter

The claimed invention is a dispenser for absorbent sheet products (preferably paper napkins). The dispenser as recited in claim 1, the only independent claim on appeal, is characterized by a body and a stand, with the body being shaped in two sections that are angled relative to one another, and when mounted on the stand, are each angled obliquely relative to the horizontal (page 3, line 16 to page 4, line 2). The upstream body section is more nearly vertical, whereas the downstream body section is

more nearly horizontal (page 7, line 24 to page 8, line 3).

It has been found that a dispenser having the above structure permits storing and dispensing a relatively large volume of sheet products while occupying a relatively small area of counter space. Furthermore, such a structure is considerably more stable than the vertically-oriented countertop dispensers of the prior art (see discussion of prior art at pp. 1-3 of the specification).

(vi) Grounds of Rejection to be Reviewed on Appeal

There are now five issues on appeal, namely:

1) Whether claims 1-13 would have been obvious, within the meaning of 35 USC §103(a), based on the combined disclosures of Wheeler (U.S. Patent No. 1,898,983) in view of Petterson (U.S. Patent No. 5,100,020);

2) Whether claims 1-13 would have been obvious, within the meaning of 35 USC §103(a), based on the combined disclosures of Breger (U.S. Patent No. D310,923) in view of Petterson;

3) Whether claims 1-13 would have been obvious, within the meaning of 35 USC §103(a), based on the

combined disclosures of Hubanks (U.S. Patent No. 6,543,641) in view of Petterson;

4) Whether claim 14 would have been obvious, within the meaning of 35 USC §103(a), based on "any of the above combinations" and further in view of Margulies (U.S. Patent No. 4,526,291); and

5) Whether claims 15 and 16 would have been obvious, within the meaning of 35 USC §103(a), based on "any of the above combinations" and further in view of Boone et al (U.S. Patent No. 4,526,291).

(vii) Argument

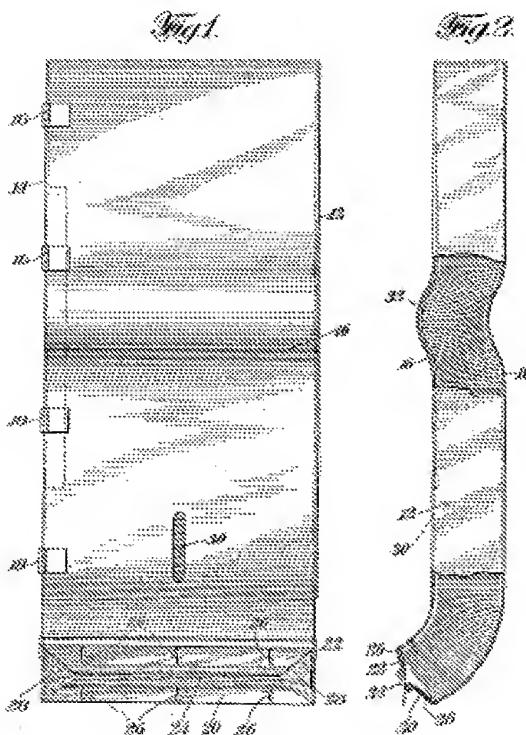
**Claims 1-13 are non-obvious
over Wheeler and Petterson**

Appellants note initially that both Wheeler and Petterson were of record at the time of the previous appeal. The September 30, 2008 official action purports to cite Wheeler on the attached Form PTO-892, but Wheeler had already been cited by the previous Examiner on the Form PTO-892 that accompanied the official action of April 20, 2006. It is not apparent from the record why Wheeler would be cited a second time on a second Form PTO-892 in a subsequent official action.

On the merits, the proposed combination of Wheeler and Petterson made in the rejection on appeal is reminiscent of the proposed combination of Swift and

Petterson that was discussed in the dissenting opinion that accompanied the Board's June 25, 2008 decision (but with which the majority disagreed), except that the proposed combination of Wheeler and Petterson is actually far less cogent.

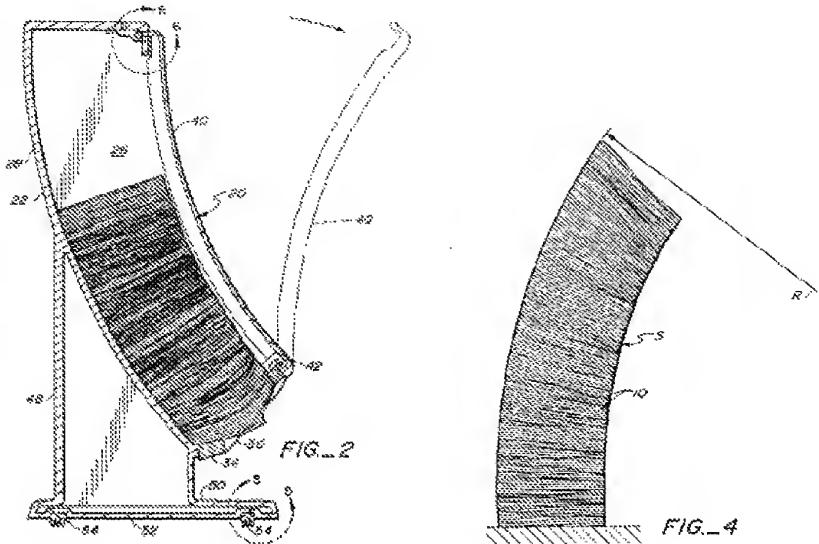
Wheeler depicts a very tall towel cabinet which its figures show to be oriented vertically:



Page 1, line 81 of Wheeler confirms that the cabinet comprises "a vertical box."

Petterson was of course the primary reference in the previous appeal, and is now relied upon again as a secondary reference. As the Board will recall, it describes a dispenser whose body is continuously curved,

so as to follow the natural angle of repose of a particular type of napkin stack to be housed therein:



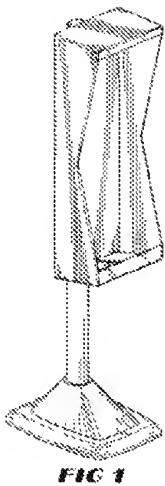
The rejection on appeal contends merely that

"[i]t would be [sic, would have been] obvious to one skilled in the art to mount the Wheeler [dispenser] to a stand as taught by Petterson because it allows for a high capacity dispenser to be used on a counter top, or other narrow flat surfaces."

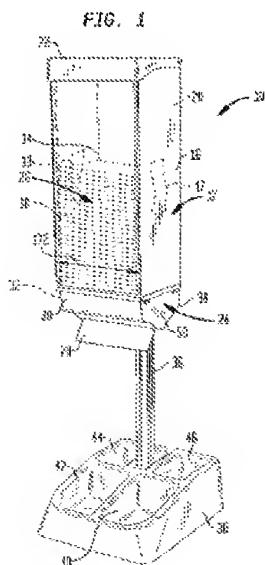
The rejection does not burden its attempted hindsight reconstruction of the present invention with any consideration of why the skilled artisan would have chosen in particular the Petterson dispenser, designed as it is for dispensing a particular type of napkin exhibiting a particular natural angle of repose, as a basis for modifying a wall-mounted paper towel dispenser, especially considering that Petterson does not even describe any

"stand" that is distinct or separable from its overall dispenser.

Of course, tall stand-mounted dispensers are already known in the art, as discussed at page 2, lines 15-21 of the present specification, with reference to U.S. Patent No. D463,183:



Another example appears in U.S. Patent No. 6,899,251:



However, neither of these arrangements satisfies the requirement of present claim 1 that not only the downstream section but also the straight upstream section of the dispenser body must form oblique angles to the horizontal.

Likewise, the newly-proposed combination of Wheeler and Petterson would not meet that requirement of claim 1. Indeed, the Examiner fails even to address this point in the newly-applied rejection. Furthermore, the Wheeler dispenser is so tall that it would obviously be too top-heavy to mount inclined on a stand, quite apart from the fact there is not the slightest suggestion to do so in either applied reference.

The newly-formulated combination of Wheeler in view of Petterson is still further fatally defective in that claim 1 requires that the straight upstream section of the dispenser body "extends over the majority of the length of said body." That aspect of claim 1 is plainly not true of Wheeler. Instead, Wheeler's cabinet, as shown in Fig. 2 of the reference, includes two straight upstream sections, neither of which extends over the majority of the length of the Wheeler cabinet body. We note that the newly-issued office action also does not even address this additional critical shortcoming of Wheeler and Petterson.

As the Board will recall from the first appeal, the majority declined to adopt the dissent's suggestion of adding Petterson's stand to the vertical-mount cabinet of Swift (U.S. Patent No. 1,151,064), noting that the majority saw "no articulable reasoning having rational underpinnings" to consider that combination as obvious. Here, the newly-assigned Examiner has substituted a previously-cited and less relevant reference for Swift and proposed essentially the same type of combination that the majority previously considered and found wanting.

From the above discussion, it is believed to be apparent that the newly-applied rejection of claims 1-13 as allegedly being obvious based on the proposed combination of Wheeler and Petterson is wholly lacking in merit. Indeed, the approach taken in the official action would have been less than fully satisfactory if the rejection were a first action on the merits; however, it is all the more remarkable coming as it does on the heels of the June 25, 2008 Board decision that reversed the previously applied grounds of rejection and declined to adopt a similar (albeit considerably more cogent) rationale proposed by the dissent.

**Claims 1-13 are non-obvious
over Breger and Petterson**

The Breger design patent was not previously of record, but is at best cumulative of the Hubanks and Swift

patents, which were. Being a design patent, it can offer no relevant teaching other than its appearance. However, even that limited disclosure speaks strongly to the nonobviousness of the present claims.

Like Hubanks and Swift, Breger depicts a dispenser that has an inclined lower section and a straight vertical upper section:

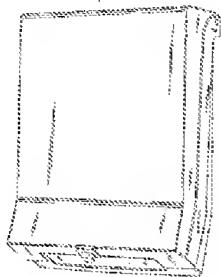
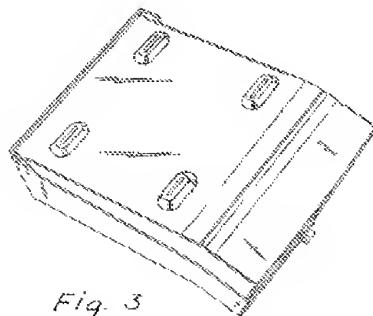


Fig. 1

Also like Hubanks and Swift, the Breger dispenser is specifically designed for mounting on a vertical surface, as confirmed by the mounting bosses visible in Fig. 3 of the patent:



As for the purported rationale to modify Breger in view of Pettersson, the official action again merely contends that

"[i]t would be [sic, would have been] obvious to one skilled in the art to mount the Breger [dispenser] to a stand as taught by Petterson because it allows for a high capacity dispenser to be used on a counter top, or other narrow flat surfaces."

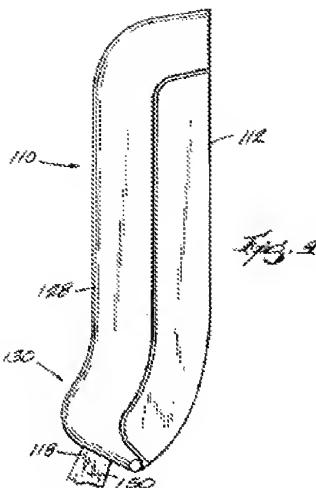
That is of course the identical rationale provided for the proposed combination of Wheeler and Petterson, and it suffers from the same fundamental infirmities, namely: the selection of Petterson for a teaching of a "stand" to be used for the wall-mounted Breger dispenser is an unabashed attempt to effect a hindsight reconstruction of the present invention (which fails in any event); and there is no suggestion in either reference to position the Breger dispenser on the Petterson stand such that the straight vertical upstream section of the Breger dispenser be inclined at an oblique angle to the horizontal, rather than remaining in a vertical orientation as was conventional in this art. Again, the rejection on appeal fails even to address this latter fundamental shortcoming of its newly proposed combination of references.

The proposed combination of Breger and Petterson is thus no more sustainable than that of Wheeler and Petterson, and plainly did not justify reopening prosecution of this application following a Board decision favorable to Appellants as to all issues on appeal.

**Claims 1-13 are non-obvious
over Hubanks and Petterson**

As with the newly-formulated rejection based on Wheeler and Petterson, this rejection again relies solely on prior art that was of record at the time of the previous Board decision. The September 30, 2008 official action again purports to "cite" Hubanks in the form of the issued U.S. Patent No. 6,543,641, but in fact Hubanks was already of record in the form of the corresponding published application 2001/0020624 that was cited by Appellants in an IDS on April 15, 2005, and which the previous Examiner considered as evidenced by the initialed Form 1449 attached to the official action of July 29, 2005. Once again, it is not apparent from the record why a reference previously considered would be "cited" a second time in a subsequent official action, as if it presented a new issue.

On the merits, the newly formulated combination of previously considered prior art is indistinct from the proposed combination of Breger and Petterson discussed above. Like Breger (and Swift), Hubanks shows a dispenser that has an inclined lower section and a straight vertical upper section:



As with Breger and Swift, it is clear that the Hubanks dispenser is to be mounted with the straight upstream section oriented vertically. In addition to the figures, see, for example, col. 7, lines 42-45 of Hubanks.

The purported rationale provided by the rejection on appeal to modify Hubanks in view of Petterson is the identical conclusory allegation offered for each of the previous rejections. Only the names have changed:

"[i]t would be [sic, would have been] obvious to one skilled in the art to mount the Hubanks [dispenser] to a stand as taught by Petterson because it allows for a high capacity dispenser to be used on a counter top, or other narrow flat surfaces."

It follows that the clear deficiencies of that rationale also apply once again, i.e., the rather blatant hindsight selection of Petterson for a teaching of a stand to be used for the wall-mounted Hubanks dispenser, and the lack of any suggestion in either reference to position the

Hubanks dispenser on the Petterson stand such that the straight vertical upstream section of the Hubanks dispenser be inclined at an oblique angle to the horizontal, rather than remaining in a vertical orientation as was conventional in this art (with the official action once again failing even to address this latter fundamental shortcoming of its newly proposed combination of references).

The rejections of the dependent claims 14-16 are simply the corresponding rejections from the previous appeal served warmed-over. Thus, upon reversal of the rejections discussed above the law of the case is that these latter rejections must fall with those of claims 1-13.

Conclusion

37 CFR §1.198 requires that, after a Board decision has become final, prosecution may be reopened only with the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown. That requirement is underscored by the admonitions of MPEP §1214.04, that:

“The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application or *ex parte* reexamination proceeding has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the

appeal. The second examiner should give full faith and credit to the prior examiner's search.

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP §1002.02(c) and MPEP §1214.07. The TC Director's approval is placed on the action reopening prosecution."

These precautions were adopted to curb precisely the type of excesses as occurred in this case. It is not apparent from the present record why 37 CFR §1.198 was violated or why §1214.04 was ignored in devising the rejections that necessitated this second appeal; however, it is believed that had those requirements been observed, the need for the present appeal might have been avoided.

The newly formulated rejections are therefore not only unsustainable on the merits, as discussed above, but also reflect a disturbing disregard of the Board's June 25, 2008 decision as the law of the case. Indeed, it is striking that, whereas the rejection on appeal states that "Applicants arguments...have been considered but are moot in view of the new ground(s) of rejection," the Board's decision of June 25, 2008 does not even rate a mention.

From the foregoing discussion, it is believed to be apparent that the rejections of claims 1-16 are improper and should be reversed. Such action is accordingly respectfully requested.

The appeal brief fee of \$540 was paid by credit card with the appeal brief filed December 8, 2008.

Respectfully submitted,

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(viii) Claims Appendix

1. A dispenser for holding and dispensing folded absorbent sheet products, the dispenser comprising a body and a stand, the stand comprising a base for supporting the dispenser on a horizontal surface, the body comprising two sections, wherein a first upstream one of said sections is straight and extends over the majority of the length of said body, and wherein a second downstream one of said sections extends at an angle relative to said first section and communicates with a dispensing opening, and wherein, when said dispenser is supported by said stand on said horizontal surface, each of said first and second sections forms an oblique angle relative to said horizontal surface, said first section forming an angle that is more nearly vertical, and said second section forming an angle that is more nearly horizontal.

2. The dispenser according to claim 1, wherein said stand is detachable from said body.

3. The dispenser according to claim 2, wherein said body comprises mounting structures for mounting said body on a vertical surface, such that said first straight section extends parallel to said vertical surface.

4. The dispenser according to claim 1, further comprising a stack of folded absorbent sheet products held within said body.

5. The dispenser according to claim 1, wherein said stand comprises attachment structures for fixing the dispenser to said horizontal surface.

6. The dispenser according to claim 1, wherein said stand comprises feet made of a resilient material for supporting the dispenser on said horizontal surface.

7. The dispenser according to claim 4, wherein said stack of folded absorbent sheet products are interfolded paper napkins.

8. The dispenser according to claim 1, wherein said angle formed by said first section is in the range of 45-85°.

9. The dispenser according to claim 8, wherein said angle formed by said first section is about 60°.

10. The dispenser according to claim 1, wherein said angle formed by said second section is in the range of 15-60°.

11. The dispenser according to claim 10, wherein said angle formed by said second section is about 45°.

12. The dispenser according to claim 3, wherein said mounting structures for mounting said body on a vertical surface comprise at least two openings formed in a rear wall of said body, for receiving bolts securing said body to said vertical surface.

13. The dispenser according to claim 1, wherein said body comprises a main portion and a cover, and wherein the cover is openable in relation to the main portion to expose an interior of said main portion over all of said first straight section.

14. The dispenser according to claim 13, wherein said main portion comprises peripheral flanges extending outwardly along at least part of said first section, and wherein edge regions of said cover, when closed, rest upon said flanges.

15. The dispenser according to claim 13, wherein said cover is transparent.

16. The dispenser according to claim 15, wherein said main portion is opaque.

(ix) Evidence Appendix

None.

(x) Related Proceedings Appendix

Previous Appeal No. 2007-3501, final decision rendered June 25, 2008.